

*REMARKS/ARGUMENTS**The Pending Claims*

Currently pending are independent claim 1 as amended and dependent claims 2 – 10, all of which are directed to a motor vehicle door. Reconsideration of the pending claims in view of the amendments and arguments made herein is respectfully requested.

Summary of the Amendments to the Claims

Applicants have amended claims 1, 3 and 9 to place them in better condition for allowance. Specifically, claim 1 has been amended to remove the objectionable "and/or" language and to clarify that the module support comprises "at least one receiver for the positive fit retention of the window-lifting rail." Claim 1 is also amended to include the feature that "the window lifting rail assumes a clearly defined position in relation to the module support." Support for this amendment can be generally found in the second to last paragraph on page 1 of the original application. Additionally, claim 1 is amended to remove the objectionable adjective "like" describing the step feature of the support on the window lifting rail.

Dependent claim 3 is amended to remove the objectionable "and/or" language and to clarify that the module support comprises pins. Finally, dependent claim 9 is amended to clarify that the frame comprises "both a paneling at its side distant to the motor vehicle and its side facing the motor vehicle interior." Hence, by employing the term "both," dependent claim 9 now more clearly reflects the inclusion of two panels, one on the motor vehicle door exterior and one on the motor vehicle door interior. Support for the amendment to claim 9 can be found in the last paragraph of page 3 of the originally filed application. Accordingly, it is believed that none of the amendments to the claims presents new matter beyond the scope of the original disclosure.

Summary of the Office Action

The Office Action dated September 16, 2009, rejects claims 1-10 as allegedly indefinite under 35 U.S.C. § 112, second paragraph, for failing to point out particularly and claim distinctly the subject matter of the invention. In particular, the Office Action rejects claims 1 and 3 due to the inclusion of the language "and/or" because the specification allegedly does not support multiple embodiments indicated by the and/or language. The Office

Action also alleges that the terms "positive-fit retention" and "step-like support" set forth in claim 1 are allegedly indefinite. The Office Action also alleges that claim 9 is indefinite because of unclear punctuation and because the precise quantity of the panels claimed is indeterminate.

With respect to prior art, the Office Action again alleges that claims 1, 2 and 5-10 are obvious under 35 U.S.C. § 103(a) over U.S. Publication No. 2004/0211122 (Freyduth). Claims 3 and 4 are again rejected as obvious over Freyduth in view of U.S. Publication 2004/0049988 (Reul). The Office Action states that Applicants' prior arguments for non-obviousness of the invention had been considered but were not deemed persuasive and further contends that the claims continue to read on the structure of Freyduth.

Discussion of the Indefiniteness Rejections

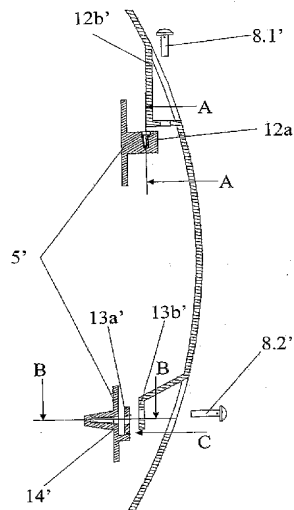
Applicants respectfully submit that amendments to the claims have overcome the rejections for indefiniteness. Regarding claim 1, Applicants have removed the objectionable language "and/or" and clarified that the claim is directed to the embodiment "wherein the module support comprises at least one receiver for the positive-fit retention." Applicants have also removed the adjective "like" following "step" and preceding "support" to overcome the indefiniteness issues with respect to the shape of the claimed support. With respect to claim 3, Applicants have likewise removed the problematic language "and/or" to clarify that the module support comprises pins.

Applicants express some dismay with respect to the indefiniteness rejection of the phrase "positive fit." This term was part of claim 1 as originally filed and thus far during the prosecution of this application there was no indication that the term was problematic. Applicants do not understand why the definiteness of the term "positive fit" is only now being raised in the third Office Action in this matter. Regardless of the rejection's properness, Applicants submit that the term "positive fit" is sufficiently clear and definite and in compliance with 35 U.S.C. § 112, second paragraph.

To comply with the definiteness requirement, the claims only need to define the subject matter with a reasonable degree of particularity. See, e.g., M.P.E.P. § 2173.02. "Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire." *Id.* Applicants may use functional language, alternative expressions, negative limitations or any style of expression or format

necessary to define the invention. See, e.g., M.P.E.P. § 2173.01. Where the claim language satisfies the requirements of 35 U.S.C. § 112, paragraph 2, but the Examiner would prefer that the language be made clearer, the claims should not be reject but rather the Examiner should suggest improved language for the claims. See, e.g., M.P.E.P. § 2173.02.

A positive fit is one in which the connection between two or more parts is maintained by the shape of the parts in abutting or encompassing each other in a manner that provides for the parts to connectively support each other while still allowing for relatively easy disassembly. Hence, it is the shape of the parts that connectively accommodate each other. This is in contrast to connections maintained by a friction force (such as a force fit or non-positive fit) or by atomic or molecular forces. The specification gives examples of positive fit connections such as the shoulder 12a of the module support on which rests the step support 12b of the window rail or the pocket 13a of the module support which can receive the projection 13b. These examples are described at the second to last paragraph of page 2 and are shown in FIG. 1a of the application, reproduced below.



The specification distinguishes positive fit retention from more permanent connections such as screws. See, e.g., paragraph 7 of page 1. Further, with respect to the alleged indefiniteness of the term "pocket-like," Applicants note element 13a shown in FIG. 1a above depicts a slot-like pocket for receiving a projection 13b. One of skill in the art would understand from that depiction that the term "pocket" as used in the claim assumes its ordinary meaning of a cavity or enclosure for receiving something. Hence, one of skill in the art will recognize that positive fit retention, such as that provided by a pocket, is based on the interaction between the complementary shapes of the two connected parts and not be means of some more permanent

connection method such as screws or adhesives. Applicants respectfully request that the indefiniteness rejection of the term "positive fit" be withdrawn or, in the alternative, that the Examiner suggest a more acceptable term.

Regarding claim 9, Applicants have amended it to clearly claim a "frame comprising both a panelling at its side distant to the motor vehicle as well as and its side facing the motor vehicle interior." It is believed that the term "both" as used in claim 9 clarifies that two panels are used, one on the exterior and another on the interior of the vehicle door. In light of the foregoing comments, Applicants believe that all indefiniteness rejections have been overcome.

Discussion of the Prior Art Rejections

Applicants again submit that the invention as claimed is patentable over the prior art of Freymuth and Reul for several reasons. First, the Office Action makes the conclusory allegation that the "at least one receiver having a projection supporting a step support of the window lifting rail for accommodating the vertical weight forces of the window lifting rail" is disclosed by the lower fixing area of Freymuth. In particular, the Office Action identifies the stop surface 14 to be the same as the claimed projection. Regardless of whether the stop surface 14 is structurally the same as a projection or whether it projects from the plane of the door, neither of which are clear from FIG. 1, the stop surface does not support a step support but instead lies merely adjacent to the lower cable guide. Freymuth does not teach the structural limitation of a projection supporting, i.e. physically holding up, a step support.

Second, although conceding that in Freymuth the bearing axis 400b that fixes to the stop surface 14 is horizontal with respect to the vehicle vertical axis, the Office Action cites M.P.E.P. § 2144.04(VI) for the unfounded proposition that it would be obvious to re-orientate the bearing axis to disclose a bore and a screwing running in the vehicle vertical axis. However, this section of the M.P.E.P. also cautions:

The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device.

M.P.E.P. § 2144.04(VI). The Office Action does not identify any reason or suggestion why one of skill in the art would rearrange the horizontal bearing axis 400b and whatever associated bore in the stop surface 14 in Freymuth to run in the vertical direction as per the

claims. In fact, one of skill in the art would not undertake such a rearrangement because doing so would destroy the operability of Freymuth. In Freymuth, it is clear that the guide rail is swivelled or pivoted by its upper fixing point so that the lower cable guide is moved in the horizontal direction adjacent to the stop surface 14. If the horizontal bearing axis 400b is reoriented vertically, it could not fix to the stop surface 14 in the manner shown in FIG. 1 and therefore would defeat the purpose of having a pivotal guide rail. See, e.g., M.P.E.P. § 2143.01(VI) ("The Proposed Modification Cannot Change the Principle of Operation of a Reference"). Not only does the Office Action fail to identify a reason to rearrange Freymuth, the proposed rearrangement impermissibly renders Freymuth inoperable.

An advantageous result of the vertical orientation and positive fit retention set forth in claim 1 is that the "screwing does not need to accommodate weight forces of the window lifting rail." The Office Action makes the unsupported finding that such a result is present in Freymuth. However, the Office Action does not identify any part of Freymuth explicitly disclosing that claimed feature, nor does the Office Action provide any detailed rationale about why such a feature is inherent in Freymuth. Because there is no reason one of skill would rearrange the horizontal orientation of Freymuth to arrive at the vertical orientation of the claim, there is likewise no reason why one of skill would inevitably arrive at an arrangement wherein the "screwing does not need to accommodate weight forces of the window lifting rail." This claimed feature is not obvious.

Furthermore, claim 1 as amended positively recites that "the window-lifting rail assumes a clearly defined position in relation to the module support" as a result of the positive fit retention of the window lifting rail with the receiver of the module support. This unique feature resulting from the positive fit retention is absent in Freymuth which instead discloses using a pivotal bearing to allow swivelling of the guide rail with respect to the assembly opening of the door. Accordingly, the added feature is not obvious from Freymuth. The disclosure of Reul fails to remedy the deficiencies of Freymuth noted above such that any combination of Freymuth and Reul cannot render claim 1 unpatentable.

To support the rejection of a claim as obvious, the prior art reference or references as combined must teach or suggest every element of the rejected claim. See, e.g., M.P.E.P. § 2143. Because independent claim 1 is patentable as demonstrated above, Applicants submit that dependant claims 2-10 are likewise patentable.

Conclusion

Applicants respectfully submit that the patent application is in condition for allowance. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

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